

REMARKS

Applicants note that by the present amendment, the Cross Reference to Related Application has been corrected in the manner suggested by the Examiner, and it is noted that claims 45 and 46 as added by the Amendment filed on June 9, 2003 have been renumbered as claims 46 and 47, with claim 47 being amended to depend upon claim 26, thereby avoiding the points raised by the Examiner.

With respect to the Examiner's indication that applicant failed to respond to the requirement that the original patent or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed, applicants note that submitted with the original reissue application was a paper entitled "Reissue Application by the Assignee, Offer to Surrender Patent" wherein an offer to surrender the original patent was presented by the undersigned attorney acting on behalf of the assignee, and it is noted that the Examiner has recognized that the assignee has proper authority to act in this application. Again, the offer is outstanding and upon an indication of allowable subject matter, the original patent will be surrendered, noting that 37 CFR 1.178 does not require surrender of the original patent at the time of filing of an application, but indicates that a statement or surrender must be supplied before the application is allowed. Upon an indication of allowable subject matter, applicants will submit the necessary document.

Applicants note that in light of the amendment of renumbered claim 47 to depend upon claim 26, the rejection of claim 47 under 35 U.S.C. §112, second paragraph, has been overcome as recognized by the Examiner at paragraph 18 at page 10 of the Office Action.

Also, by the above amendment, independent claim 32 has been amended to delete "consists of" and insert therefor "comprises" such that this claim now recites "an image signal peripheral circuit which comprises a switch matrix circuit connected

to said display region on one substrate of said pair of substrates; and". Additionally, claims 25, 27, 34, 39 and 43 have been amended to delete the term "island" and insert therefor "portion". Thus, such claims now recite the feature that the image signal peripheral circuit includes a plurality of semiconductor elements having at least one semiconductor portion annealed by laser irradiation.

Turning to the rejections as set forth by the Examiner, applicants will respond in the manner of the rejections as set forth in the Office Action while citing to the original Patent No. 5,798,744.

The rejection to claims 24, 25, 27-46 and 47 under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought, is traversed insofar as it is applicable to the present claims.

With respect to the recitation in claim 46 "analog image signals", irrespective of the position set forth by the Examiner, applicants submit that as described in col. 9, line 62 to col. 10, line 15 of the original patent:

Fig. 17 shows an outline of the driving waveforms for the liquid crystal display apparatus and the driver switches the data V_{dd1} in a time of 1/8 of the line selecting time t_L. The image signals V_{d1}, V_{d2}, V_{d3} and V_{d4} are charged to respective signal lines. The above signals are charged to liquid crystal capacitors by the TFT of the pixel at a back half time t_{L2}. The image signal V_D supplied by the signal (drain line) is applied to the liquid crystal by making the pixel TFT (orderly scanning line) conductive by applying a voltage in order (from V_{Gn-1} to V_{Gn} and subsequently the next row, although not shown in the figure) to the gate lines (scan lines). The liquid crystal is driven by a voltage representing the difference between the potential V_{COM} of the common electrode at the counter substrate side and V_{Dn}, and thereby the light transmittance at the pixel is changed. (emphasis added)

Applicants submit that this disclosure as present in the original patent specification describes "analog image signals" irrespective of the position set forth by the Examiner. See In re Wright, 9 USPQ2d 1649 (Fed. Cir. 1989). Accordingly, the Examiner's position with respect to claim 46 is improper and should be withdrawn.

With respect to claims 25, 27, 34, 39 and 43, applicants note that in each of these claims, the term semiconductor "island" has been changed to semiconductor "portion". Apparently, the Examiner contends that there is no disclosure concerning annealing by laser radiation of a semiconductor island. Irrespective of this position by the Examiner which is considered to be improper, there can be no question that whether the semiconductor elements are in the display region as recited in claim 25 or a peripheral region as recited in claims 27, 34, 39 and 43, applicants submit that col. 7, lines 7-9, lines 25-28, lines 54-60, col. 8, lines 6-12 and col. 9, lines 34-37 and lines 50-53 of the original patent, describe laser annealing of semiconductor portions in both the display portion and peripheral portion as obtained by irradiation of laser, and applicants submit that these features, as claimed, find full support in the original patent specification.

With respect to the features of claim 24 that the at least one driver circuit is separate from the pair of substrates, applicants submit that such language merely provides that the driver circuit is a separate member from that of a substrate. While the Examiner contends that there is a lack of disclosure concerning this feature, in particular, since col. 10, lines 16-19 and 34-45 describes how driver circuit 21 is formed onto substrate 10 by COG technology, apparently, the Examiner is unaware of the meaning of COG, which is defined in the original patent specification at col. 1, lines 20-24, which describes "COG (Chip On Glass) method, wherein the external driver is directly connected to the substrate by soldering or by using metallic paste" (emphasis added). Thus, if the Examiner contends that COG is an integration of the driver into the substrate, such is clearly improper, and it is apparent that the driver 21 is an external and separate member which is mounted on the substrate but is separate from the substrate as recited in claim 24. Hereagain, the Examiner's position concerning new matter is improper and should be withdrawn.

With respect to claims 32, 38 and 42, which the Examiner indicates claim "an image signal peripheral circuit having a switch matrix", apparently the Examiner contends that irrespective of the description in the specification at col. 6, lines 39-43 and illustrated in Fig. 4, shows a TFT switch matrix, such claims do not have support in that the "newly claimed switch matrix circuit is broader than the described peripheral circuit 51 of the switch matrix type in view of figure 4 showing a TFT switch matrix, and since a switch matrix circuit may use other circuit elements in addition to the TFTs to form the switch matrix" (emphasis added). The position of the Examiner is not understood. The fact remains that an image signal peripheral circuit formed of a switch matrix circuit is described in the original patent specification, irrespective of whether a TFT switch matrix circuit is illustrated and disclosed. It is noted by the present amendment, claim 32 has been amended to utilize the term "comprises" rather than "consists of", it being noted that claims 38 and 42 recite the feature of "having" such that the terminology is considered to be open ended, and the only question is whether the original patent supports the claimed subject matter, which there is clear support for. It is noted that the Examiner did not reject dependent claim 37 which recites the feature that the switch matrix circuit comprises thin-film transistors, i.e. TFT, on the basis of new matter and applicants note that applicant is entitled to claim the invention as broadly as possible insofar as there is support for the claimed subject matter. Thus, hereagain, the Examiner's position concerning new matter is improper and should be withdrawn.

As to the rejection of claims 24, 25, 27-46 and 47 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, applicants submit that this position by the Examiner is improper and should be withdrawn for the reasons given above concerning the Examiner's position concerning "new matter". Thus, applicants submit that all claims present in this application are in

compliance with 35 U.S.C. §112 as well as 35 U.S.C. §251 and the rejections as set forth by the Examiner should now be overcome.

As to the rejection of claim 47 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention, in accordance with the Examiner's suggestion, claim 47 has been amended to depend from claim 26, thereby overcoming the rejection under 35 U.S.C. §112, second paragraph.

As to the rejection of claims 23-47 under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based, this rejection is traversed insofar as it is applicable to the present claims.

Irrespective of the Examiner's position and the citation of decisions, applicants submit that the decisions have been clarified and/or overruled to the effect that such decisions are inconsistent with the decision of Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003). Applicants submit that this decision clarifies that applicants are entitled to an intermediate scope of protection between the scope of the issued claim and the scope of the rejected claim, and 35 U.S.C. §251 envisions that errors made without deceptive intent can be corrected after a patent has issued under the defined circumstances of 35 U.S.C. §251. Applicants note that the reissue application of which the present application is a continuation, was filed August 24, 2000, within two years from the issue date of August 25, 1998, and is a broadening reissue. Applicants submit that the decision of Ex parte Eggert, supra, requires the Examiner to perform the analysis as set forth and it is apparent that the statements as set forth by the Examiner do not relate to the analysis as required, such that applicants submit that applicants are entitled to claim the subject matter as set forth in this application in accordance with this decision, and the burden is upon the Examiner to set forth appropriate reasoning, other than that now present, to which

applicant can submit a suitable reply. In this regard, applicants understanding is that in light of the aforementioned decision, the Board of Patent Appeals and Interferences has remanded most, if not all, appeals in which a reissue application having an issue of recapture is presented to the Examiner for reconsideration in light of the decision. Applicants submit that consideration by the Examiner based upon such decision is appropriate herein and it is evident that the issue of "recapture" as framed by the Examiner is contrary to the aforementioned decision.

As to the rejection of claims 23-27 , 29, 30, 32-34, 38, 39, 42, 43, 46 and 47 under 35 U.S.C. §102(e) as being anticipated by Mochizuki et al, U.S. Patent No. 5,247,375 and the rejection of claims 23, 24, 26, 29, 30, 32, 33, 38, 42, 46 and 47 under 35 U.S.C. §102(b) as being anticipated by Misawa et al, U.S. Patent No. 5,250,931, such rejections are traversed insofar as they are applicable to the present claims, and reconsideration and withdrawal of the rejections are respectfully requested.

At the outset, it is noted that the rejections as set forth do not include pending claims 28, 31, 35-37, 40, 41 and 45, such that at least these claims, as amended, are at least acknowledged by the Examiner to patentably distinguish over this cited art.

As to the requirements to support a rejection under 35 U.S.C. 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and

that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Turning to Mochizuki et al, irrespective of the position and improper analysis set forth by the Examiner, it is apparent that with respect to claim 23 which recites the feature of "at least one driver circuit...being arranged outside of a region which is held between said pair of substrate" (emphasis added), Fig. 1B of Mochizuki et al clearly discloses that the drive circuits 12, 13, 19A and 19B, as at least partially acknowledged by the Examiner, are disposed "between both of the glass substrates" representing the substrates 10A and 10B of the liquid crystal display apparatus. Thus, the Examiner acknowledges that Mochizuki et al fails to provide the recited features of claim 23, even though the Examiner contends that such features are inherent therein. See In re Robertson, supra. Thus, applicants submit that claim 23 and the dependent claims patentably distinguish over Mochizuki et al in the sense of 35 U.S.C. 102. Likewise, the Examiner improperly contends that features are present or inherent in the cited art in relation to the claimed invention as recited in the other independent and dependent claims, and applicants submit that all claims patentably distinguish over the cited art and should be allowable thereover..

With respect to Misawa and the Examiner's attempt to read such patent on pending claim 23, it is again noted that claim 23 recites the feature of "at least one driver circuit...being arranged outside of a region which is held between said pair of substrate" (emphasis added). Applicants note that Fig. 1 of Misawa illustrates a source line driver circuit 12 and a gate line driver circuit 21 formed on a transparent substrate 11. Applicants submit that another corresponding sized substrate (not shown or described) to the substrate 11 is provided, and that the driver circuits 12 and 21 are arranged between the substrate 11 and the another substrate, which is

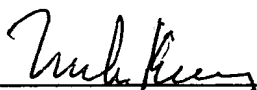
not illustrated, forming a part of the liquid crystal display apparatus, such that irrespective of the contention by the Examiner, Misawa fails to disclose in the sense of 35 U.S.C. 102 or teach at least one driver circuit arranged outside of the region which is held between the pair of substrates, wherein the at least one driver circuit is electrically connected to at least one peripheral circuit for driving the at least one peripheral circuit as defined. As such, applicants submit that claim 23 and the dependent claims patentably distinguish over Misawa in the sense of 35 U.S.C. 102 and should be considered allowable thereover.

As to the other independent and dependent claims, the Examiner fails to even attempt to apply Misawa to all claimed features in order to support a rejection under 35 U.S.C. 102. Thus, applicants submit that the independent and dependent claims of this application patentably distinguish thereover.

In view of the above amendments and remarks, applicants submit that all claims present in this application are in compliance with 35 U.S.C. §112, first and second paragraphs, 35 U.S.C. §251 and patentably distinguish over the cited art and should now be in condition for allowance. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (503.33904RC1) and please credit any excess fees to such deposit account.

Respectfully submitted,



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